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10/764,739	01/26/2004	Michael P. Connelly	1842.011US1	8635

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EXAMINER	
BOND, CHRISTOPHER H	

ART UNIT	PAPER NUMBER
3714	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/764,739	CONNELLY, MICHAEL P.	
	Examiner	Art Unit	
	Christopher H. Bond	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3/11/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The Information Disclosure Statement filed March 11, 2004 has been acknowledged.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference number 100. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 16 and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

5. The applicant's instant invention refers generally to a gaming machine that allows for playback of a plurality of audio elements to create a played audio track. While the applicant's specification mentions that audio tracks 'of' differing sampling rates may be used, it fails to mention that the machine itself would be doing the 'recording'.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 16 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. It is unclear what the applicant is claiming as his/her invention. For examination purposes, the Examiner interprets these claims to mean 'playback/combination of audio tracks of different sampling rates', as the applicant has failed to point out in the specification how this invention can be used as a recording device.

Claim Rejections - 35 USC § 102

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. **Claims 1, 2, 12, 18-20, 30, 35-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Koenig et al., USPAT 6,729,618 (Koenig).**

10. As to claims 1, 19, and 37, Koenig presents a method and apparatus for playing a game utilizing a plurality of sound lines which are components of a song or ensemble. Koenig discloses (column 1, lines 7-12), "...a game utilizing a plurality of sounds lines (i.e. audio elements) which are components of a song or ensemble (i.e. audio track), each of which may be reproduced either alone or together with any number of the other sound lines. The game is preferably included as an adjunct, secondary event, bonus feature to a basic casino video game." It is clear, that processor and gaming codes are inherent parts of a basic casino video game. This would meet the applicant's limitation of having a gaming module with a processor and gaming code which, when operated, conducts a wagering game, and an audio module that plays an audio track comprised of a plurality of selected audio elements that are played at the same time to create the played audio track.

11. Furthermore, the method of providing audio from a computerized gaming system comprised of playing an audio track with a plurality of audio element tracks played at the same time, where the computerized gaming system is further operable to conduct a wagering game upon which monetary value can be wagered, as disclosed by the applicant, merely discloses the steps of the gaming system's operation, and since each element must be implemented in order to make the device, the method would have been inherent in view of the device.

12. Accordingly, claims 1, 19, and 37 would have been anticipated.

13. Regarding claims 2, 18, 20, and 36, Koenig discloses (column 7, lines 27-32) that, "...each sound line consists of essentially of musical sounds corresponding to an instrument or voice and wherein the instrument or voice corresponding to the musical sounds of one sound line is substantially different from the instrument or voice corresponding to the musical sounds of each other sound line." This would meet the applicant's limitation of having an audio element track, where each audio element track comprises one or more instruments not present in the other audio element tracks. This would also meet the applicant's limitation of having an audio element track comprised of sound effects, as it is clear that sound effects are a narrower limitation of sound in general, which Koenig anticipates.

14. Furthermore, the method of having an audio element track comprised of one or more instruments not present in the other audio element tracks and an audio track where at least one element comprises sound effects, as disclosed by the applicant, merely discloses the steps of the gaming system's operation, and since each element must be implemented in order to make the device, the method would have been inherent in view of the device.

15. Accordingly, claims 2, 18, 20 and 36 would have been anticipated.

16. As to claims 12 and 30, Koenig as discussed above discloses that the sounds lines may be reproduced alone or together with any number of other sound lines. This would meet the applicant's limitation of having and audio track further comprised of a portion that is not a combination of audio element tracks.

17. Furthermore, the method of having a played audio track comprised of a portion that is not a combination of audio element tracks, as disclosed by the applicant, merely discloses the steps of the gaming system's operation, and since each element must be implemented in order to make the device, the method would have been inherent in view of the device.

18. Accordingly, claims 12 and 30 would have been anticipated.

19. In regards to claims 17 and 35, as discussed above, Koenig discloses that the sound lines are component of a song (music) or ensemble. This would meet the applicant's limitation of having an audio element tracks where at least one audio element track comprises music.

20. Furthermore, the method wherein at least one of the audio element tracks comprises music, as disclosed by the applicant, merely discloses the steps of the gaming system's operation, and since each element must be implemented in order to make the device, the method would have been inherent in view of the device.

21. Accordingly, claims 17 and 35 would have been anticipated.

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

23. **Claims 3-11, 13-16, 21-29, and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koenig.**

24. As to claims 3-11, 13, 21-29, and 31, the long existence of a Musical Instrument Digital Interface (i.e. MIDI) as a communications protocol as well as MIDI controllers (including sequencers and show controllers), well known to those skilled in the art, would allow one to perform all the common limitations as listed by the applicant—including, but not limited to: phrasing an audio element track, out of sequence playback, random phrase playback, ordered list playback of phrases, priority weighting of phase playback, random combinations of audio tracks, combinations of audio tracks based on a predetermined list, playback of audio elements with different lengths, and audio tracks played with randomized parameters (volume, panning, reverb, equalization, compression, distortion, flange, and phase). Moreover, these limitations have long been practiced by soundboard/audio/broadcast/recording engineers and when viewed vis-à-vis the gaming machine (i.e. an audio output device) are nothing novel.

25. As to claims 3 and 21 specifically, Koenig discloses the claimed invention except for the limitation of audio tracks comprising one or more specific instruments having multiple phrases independently selectable for playback to create the played audio track. It would have been an obvious matter of design choice to offer playback of audio tracks with multiple phrases, independently selectable, as applicant has not disclosed that playing audio tracks in this manner solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well without this limitation. Additionally, those skilled in the art would recognize that the limitation of

phrasing an audio track could easily be done with software/hardware and is a common practice/knowledge in the recording art—doing such vis-à-vis a gaming machine presents nothing novel, and would have been obvious design modification to the Koenig invention.

26. Furthermore, the method of playing an audio track with multiple phrases independently selectable for playback to create the played audio track, merely discloses the steps of the gaming system's operation, and since each element must be implemented in order to make the device, the method would have been obvious in view of the device.

27. Accordingly, claims 3 and 21 would have been obvious.

28. As to claims 4 and 22 specifically, the applicant's limitation of multiple phrases played back out of sequence to create the played audio track, would have been a mere matter of design choice, as applicant has not disclosed that playing audio tracks in this manner solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well without this limitation. Additionally, those skilled in the art would recognize that the limitation of creating an audio track by playing back multiple phrases out of sequence could easily be done with software/hardware and is a common practice/knowledge in the recording art—doing such vis-à-vis a gaming machine presents nothing novel, and would have been obvious design modification to the Koenig invention.

29. Furthermore, the method of playing multiple phrases played back out of sequence, merely discloses the steps of the gaming system's operation, and since each

element must be implemented in order to make the device, the method would have been obvious in view of the device.

30. Accordingly, claims 4 and 22 would have been obvious.

31. Regarding claims 5 and 23, the applicant's limitation of randomly selected phrase order would have been a matter of design choice, as applicant has not disclosed that playing audio tracks in this manner solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well without this limitation. Additionally, those skilled in the art would recognize that the limitation of randomly selected phrase order could easily be done with software/hardware and is a common practice/knowledge in the recording art—doing such vis-à-vis a gaming machine presents nothing novel, and would have been obvious design modification to the Koenig invention.

32. Furthermore, the method of playing an audio track with randomly selected phrase order, merely discloses the steps of the gaming system's operation, and since each element must be implemented in order to make the device, the method would have been obvious in view of the device.

33. Accordingly, claims 5 and 23 would have been obvious.

34. As to claims 6 and 24, the applicant's limitation of phrase playback provided by and ordered list of phrases would have been a matter of design choice, as applicant has not disclosed that playing audio tracks in this manner solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well without this limitation. Additionally, those skilled in the art would recognize that the

limitation of phrase playback by ordered list could easily be done with software/hardware and is a common practice/knowledge in the recording art—doing such vis-à-vis a gaming machine presents nothing novel, and would have been obvious design modification to the Koenig invention.

35. Furthermore, the method of phrase playback provided by and ordered list of phrases, merely discloses the steps of the gaming system's operation, and since each element must be implemented in order to make the device, the method would have been obvious in view of the device.

36. Accordingly, claims 6 and 24 would have been obvious.

37. As to claims 7 and 25, the applicant's limitation of phrase sequence selected by priority weighting assigned to the phrases would have been a matter of design choice, as applicant has not disclosed that playing audio tracks in this manner solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well without this limitation. Additionally, those skilled in the art would recognize that the limitation of phrase sequence selection by priority weighting could easily be done with software/hardware--doing such vis-à-vis a gaming machine presents nothing novel, and would have been obvious design modification to the Koenig invention.

38. Furthermore, the method of phrase sequence selected by priority weighting assigned to the phrases, merely discloses the steps of the gaming system's operation, and since each element must be implemented in order to make the device, the method would have been obvious in view of the device.

39. Accordingly, claims 7 and 25 would have been obvious.

40. Regarding applicant's claims 8 and 26, the applicant's limitation of combining two or more audio tracks randomly to create the played audio track would have been a matter of design choice, as applicant has not disclosed that combining audio tracks in this manner solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well without this limitation. Additionally, those skilled in the art would recognize that the limitation of combining two or more audio tracks randomly to create the played track could easily be done with software/hardware—doing such vis-à-vis a gaming machine presents nothing novel, and would have been obvious design modification to the Koenig invention.

41. Furthermore, the method of combining two or more audio tracks randomly to create the played audio track, merely discloses the steps of the gaming system's operation, and since each element must be implemented in order to make the device, the method would have been obvious in view of the device.

42. Accordingly, claims 8 and 26 would have been obvious.

43. As to claims 9 and 27, the applicant's limitation wherein two or more audio element tracks are combines according to a predetermined list would have been a matter of design choice, as applicant has not disclosed that combining audio tracks in this manner solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well without this limitation. Additionally, those skilled in the art would recognize that the limitation of combining audio tracks from a predetermined list could easily be done with software/hardware—doing such vis-à-vis a

gaming machine presents nothing novel, and would have been obvious design modification to the Koenig invention.

44. Furthermore, the method wherein two or more audio element tracks are combines according to a predetermined list, merely discloses the steps of the gaming system's operation, and since each element must be implemented in order to make the device, the method would have been obvious in view of the device.

45. Accordingly, claims 9 and 27 would have been obvious.

46. In regards to claims 10 and 28, the applicant's limitation wherein two or more audio elements are selected and combined based on priority weighting would have been a matter of design choice, as applicant has not disclosed that combining audio tracks in this manner solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well without this limitation. Additionally, those skilled in the art would recognize that the limitation of selecting and combining audio track by priority weighting could easily be done with software/hardware and is a common practice/knowledge in the recording art—doing such vis-à-vis a gaming machine presents nothing novel, and would have been obvious design modification to the Koenig invention.

47. Furthermore, the method wherein two or more audio elements are selected and combined based on priority weighting, merely discloses the steps of the gaming system's operation, and since each element must be implemented in order to make the device, the method would have been obvious in view of the device.

48. Accordingly, claims 10 and 28 would have been obvious.

49. As to applicant's claims 11 and 29, the applicant's limitation, wherein the audio element tracks are played back, wherein the length of at least two of the audio tracks are of different length would have been a matter of design choice, as applicant has not disclosed that playing back of audio tracks in this manner solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well without this limitation. Additionally, those skilled in the art would recognize that the limitation of playing back tracks of different length could easily be done with software/hardware and is a common practice/knowledge in the recording art—doing such vis-à-vis a gaming machine presents nothing novel, and would have been obvious design modification to the Koenig invention.

50. Furthermore, the method wherein the audio element tracks are played back, wherein the length of at least two of the audio tracks are of different length, merely discloses the steps of the gaming system's operation, and since each element must be implemented in order to make the device, the method would have been obvious in view of the device.

51. Accordingly, claims 11 and 29 would have been obvious.

52. Regarding applicant's claims 13 and 31, the applicant's limitation of having an audio element track played using at least one randomized parameter would have been a matter of design choice, as applicant has not disclosed that playing back of audio tracks using this randomization parameter solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well without this limitation. Additionally, those skilled in the art would recognize that the limitation of

playing an audio track with at least one randomized parameter could easily be done with software/hardware and is a common practice/knowledge in the recording art—doing such vis-à-vis a gaming machine presents nothing novel, and would have been obvious design modification to the Koenig invention.

53. Furthermore, the method of having an audio element track played using at least one randomized parameter, merely discloses the steps of the gaming system's operation, and since each element must be implemented in order to make the device, the method would have been obvious in view of the device.

54. Accordingly, claims 13 and 31 would have been obvious.

55. In regards to claims 14, 15, 32, and 33, Koenig discloses the claimed invention except for the limitations wherein the phrases are sorted into at least two subgroups, and wherein the audio elements in the phrase subgroups a grouped by compatibility with other audio element phrase groups would have been a matter of design choice, as applicant has not disclosed that the sorting and grouping of the phrase subgroups solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well without this limitation.

56. Furthermore, the method wherein the phrases are sorted into at least two subgroups, and wherein the audio elements in the phrase subgroups a grouped by compatibility with other audio element phrase groups, merely discloses the steps of the gaming system's operation, and since each element must be implemented in order to make the device, the method would have been obvious in view of the device.

57. Accordingly, claims 14, 15, 32, and 33 would have been obvious.

58. As to claims 16 and 34, the applicant's limitation wherein the audio element tracks are of different sampling rates would have been a matter of design choice, as applicant has not disclosed that playing back of audio tracks using different sampling rates solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well without this limitation.

59. Furthermore, the method wherein the audio element tracks are of different sampling rates, merely discloses the steps of the gaming system's operation, and since each element must be implemented in order to make the device, the method would have been obvious in view of the device.

60. Accordingly, claims 16 and 34 would have been obvious.

Conclusion

61. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Darnell, USPAT 5,368,308; and Wohl et al., USPAT 6,079,985—as these relate to games that include playing multiple audio segments together to produce and audio track.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H. Bond whose telephone number is (571) 272-9760. The examiner can normally be reached on M-F 9:30am - 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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